

**BEST AVAILABLE COPY****RECEIVED  
CENTRAL FAX CENTER****AUG 17 2006**Amendment Dated August 17, 2006  
Serial No. 10/609,290REMARKS

Reconsideration of the rejection set forth in the Office Action is respectfully requested. By this amendment claims 1-3, 49, and 50 have been amended and new claims 53 and 54 have been added. Currently, claims 1-3, 49-51, 53, and 54 are pending in this application.

Rejection under 35 USC 112

Claims 49-51 were rejected under 35 USC 112, second paragraph, as indefinite. Applicants have amended the claims to overcome this rejection.

Double Patenting Rejection

The Examiner rejected claims 1-3 and 49-51 on the ground of non-statutory obviousness-type double patenting over claims 1-3 and 48-50 of U.S. Patent No. 6,614,791. Applicants submit herewith a terminal disclaimer to overcome this rejection and respectfully request that it be withdrawn.

Rejection of claim 1 under 35 USC 102

Claim 1 was rejected under 35 USC 102 as anticipated by Fowler (U.S. Patent No. 6,504,819). This rejection is respectfully traversed in view of the amendments to the claims and the following arguments.

Fowler teaches an Internetworking Management System (IMS) that is configured to assign Class of Service (CoS) values to virtual networks. The IMS may assign differentiated classes of services to different virtual private networks (Abstract). This allows different VPNs to be provided with priority service so that carriers can increase the amount of revenue they receive from those VPNs. (see Col. 1, lines 26-32).

The class of service is thus centrally assigned, presumably according to service level agreement or in some other manner. Once the class of service is assigned to a virtual network, the IMS will use messages to pass the assigned CoS to the Edge Forwarders on the ATM network. (See Fowler at Col. 2, lines 54-63). The Edge Forwarders then use the assigned CoS to label packets with the appropriate CoS so that the packets may be prioritized by the network elements on the ATM network. (See Col. 1, lines 42-50, Col. 3, lines 15-20).

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The IMS therefore transmits two pieces of information to the edge forwarders – the virtual network and the class of service for that virtual network. This information is transmitted via messages from the IMS to the edge forwarders, not between the edge forwarders. The edge forwarders then use the class of service information to prioritize transmission on network connections that they set up between each other on the network.

Fowler recognizes that it is possible to set up different switched virtual circuits (connections) between a pair of edge forwarders for different classes of service. (See Fowler at Col. 3, lines 18-22). However, even where this occurs, the messages correlating the class of service and VPN are not transmitted over the connections between the edge forwarders but rather are transmitted between the IMS and the edge forwarders. Moreover, within a class of service, the CoS value will not enable VPN traffic from one VPN to be distinguished from VPN traffic belonging to another VPN. Note, in this regard, that the class of service feature provides three things: Packet classification; packet level traffic management; and ATM level traffic management. (Fowler at Col. 3, lines 47-55).

Unlike Fowler, this application is focused on how two edge forwarders, or other network elements on opposite sides of a connection, may distinguish traffic that belongs to different VPNs. The starting point is an assumption that it is possible to establish a shortcut VCC through the ATM network. The issue being addressed is how to enable that shortcut VCC to be used by multiple VPNs. Fowler doesn't address this problem and the class of service values taught by Fowler don't enable traffic from different VPNs to be distinguished by the edge forwarders.

Applicants have amended claim 1 to recite "A method ... comprising the steps of: establishing a connection in the communication system; and using in-band signaling on the connection to identify Virtual Private Networks assigned to the connection." (emphasis added). Fowler does not teach or suggest a method that includes the step of using in-band signaling "on the connection" to "identify Virtual Private Networks assigned to the connection." Rather, Fowler teaches the use of a message to identify the class of service to be provided to VPNs. The message is not tied to any particular connection and is not transmitted between the edge forwarders over the connections between the edge forwarders. Thus, for these reasons, applicants respectfully submit that Fowler fails to anticipate claim 1 as amended.

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### Rejection of claims 2-3 under 35 USC 103

Claims 2-3 were rejected under 35 USC 103 as unpatentable over Fowler (U.S. Patent No. 6,504,819). Claims 2-3 depend from claim 1 and therefore are patentable for at least those reasons set forth above with respect to independent claim 1.

### Rejection of claims 49-50 and 51 under 35 USC 103

Claims 49-50 were rejected under 35 USC 103 as unpatentable over Brown (U.S. Patent No. 6,279,035) in view of Pegrum (U.S. Patent No. 6,516,417). Similarly, claim 51 was rejected under 35 USC 103 as unpatentable over Brown in view of Pegrum and further in view of Allan (U.S. Patent No. 5,946,313). These rejections are respectfully traversed in view of the fact that both Pegrum and Allan may not be used in obviousness rejections against the claims of this application.

Pegrum and Allan both qualify as prior art to this application pursuant to 35 U.S.C. 102(e)(2) as "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." Note, in this regard, that the filing date of the parent application is May 11, 1999, which is after the filing date and before the issue date of each of Pegrum and Allan.

However, pursuant to 35 U.S.C. 103(c) "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section [section 103] where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." According to MPEP 706.02(l)(3) (8<sup>th</sup> Ed. pp. 700-40 to 41) a commonly owned reference is disqualified where: (A) proper evidence is filed; (B) the reference only qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) for applications filed on or after November 29, 1999, and (C) the reference was used in an obviousness rejection.

In this instance, the parent application was filed on May 11, 1999, which is before the November 29, 1999 cut-off date. However, since the instant application is a continuation of the earlier application, and was filed after the November 29, 1999 date, commonly owned 102(e) art

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is not able to be applied in an obviousness rejection even though the parent application was filed before the November 29, 1999 date. See MPEP 706.02(I)(1).

Applicants hereby state that this application and the references (Pegrum and Allan) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s).


Therefore, since Pegrum and Allan may not be used in a 103 rejection against the claims of this application, applicants respectfully request that the rejection of claims 49-50 over Brown in view of Pegrum and the rejection of claim 51 over Brown in view of Pegrum and Allan be withdrawn.

Conclusion

Applicants respectfully submit that the claims pending in this application are in condition for allowance and respectfully request an action to that effect. If the Examiner believes an additional telephone interview would further prosecution of this application, the Examiner is respectfully requested to contact the undersigned at the number indicated below.

If any fees are due in connection with this filing, the Commissioner is hereby authorized to charge payment of the fees associated with this communication or credit any overpayment to Deposit Account No. 502246 (Ref. NN-BA0334C1).

Respectfully Submitted

  
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